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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/639,761	08/15/2000	Mayumi Noguchi	1341.1059/JDH	4065

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EXAMINER	
LIN, WEN TAI	
ART UNIT	**PAPER NUMBER**
2154	

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 09/639,761	**Applicant(s)** NOGUCHI ET AL.	
	Examiner Wen-Tai Lin	**Art Unit** 2154	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 February 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: *None*.
   Claim(s) objected to: *2,3,6,7,9 and 10*.
   Claim(s) rejected: *1,4,5,8,11-19*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: (see the attached response).
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Wen-Tai Lin
Primary Examiner
Art Unit: 2154

Wen-Tai Lin 3/7/05

General Facts

Applicant filed an amendment (A1) with argument (R1) on February 23, 2004 in response to the examiner's non-final rejection. The amendment was rejected in a final office action (F1) on April 15, 2004, and was filed with an examiner's response (E1) responding to Applicant's argument R1.

Applicant then filed RCE with amendment (A2) and argument (R2) on September 14, 2004. Such amendment (A2) was rejected and made the first office action final (F2) on November 29, 2004 due to a determination that both A1 and A2 are directed to the same invention. F2 was filed with an examiner's response (E2) responding to argument R2.

Applicant's Arguments

Specifically, Applicant argues that:

(1) The after-final amendment A2 is not the same invention as the original amendment A1;

(2) Previous ground of rejection (F2) is not sufficient to reject the amended claims (A2) (or, the examiner shifted his reasoning in F2 as compared to F1 and a new ground of rejection was added in F2); and

(3) The rejection in F2 is incomplete (or, the Examiner has not addressed the actual language and limitations of the claims).

Examiner's Response

The examiner respectfully disagrees with Applicant's argument for the following reasons:

i. As to point (1):

It is noted that in producing amendment A2 Applicant deleted the limitation: *"collects only stored generated information with priorities higher than a preset priority [upon reception of a notice ...]"* (see claim 4 of A1 and A2). Such deleted portion is found to be equivalent to the newly added feature: *"responds to notices from information generation apparatuses with priorities higher than a preset priority by collecting stored generated information from such information generation apparatuses"*, which constitutes the first half of the added features.

As a matter of fact, the mere difference between A1 and A2 is seen from the second half of the added features: *"and responds to notices corresponding to information generation apparatuses with priorities lower than the preset priority by disregarding such notices by not collecting stored generated information from respective information generation apparatuses."*

However, this second half of the newly added features does not make the invention different or distinguishable between A1 and A2 because a broad interpretation based on A1's lacking of a statement for apparatuses with priorities lower than the

preset priority leads one to conclude that the collection requests from apparatuses with priorities lower than the preset priority are ignored even without this explicitly stated second half.

ii. As to point (2): Applicant specifically points out that the examiner used *"[because of] shortage in local storage space*" as reasoning for "*discarding Krishnamurthy's lower priority information*" in F1 is different from the reasoning made in F2. That is, in F2 the examiner reasoned: "*by setting the priority threshold to the lowest level, Applicant's collection system would produce equivalent result as that of Krishnamurthy, because potentially all the generated data would be collected.*"

It is noted that the above two reasoning points were cited out of their contexts. Both reasoning points were given in both rejections F1 and F2 and were placed in the same context. For example, the former was used in F1 and F2 in claim rejections regarding the need for issuing data availability in Krishnamurthy's information generators (see page 4, paragraph 5 of F1 and page 4, paragraph 4 of F2), while the latter was given in the examiner's response (E1 and E2) to Applicant's arguments (R1 and R2) (see pages 6-7, paragraph 13 of F1 and page 8, paragraph 11(2) of F2). The latter reasoning was brought up in an explanation as how Applicant's table-based priority system could be made equivalent to Krishnamurthy's queue-based system if Applicant did not further limit or define the "preset priority".

iii. As to point (3): Specifically, Applicant disagrees with the examiner's broad interpretation of the claim languages by reasoning that "*by setting the priority threshold to the lowest level, Applicant's collection system would produce equivalent result as that of Krishnamurthy, because potentially all the generated data would be collected*".

It is noted that the above reasoning was given in response to Applicant's argument as mentioned in point (ii) above, wherein in the examiner raised an issue by saying that the so called "preset priority" was being interpreted as an arbitrary threshold because a the parameter lacks proper limitation. In both amendments A1 and A2, Applicant maintains a claim language with a broadly interpretable parameter called "preset priority" for determining which information generator's data should be collected.

In the same regard, Applicant further argues that:
"*the Examiner is reasoning that the claims have a case where the threshold is such that all notices are collected. However, the limitation of claim 4 in the paragraph above does not allow such a low threshold. Claims 1 and 4 explicitly recited notice(s) with a priority below the threshold. The Examiner's reasoning that the claims have a case where all notices are collected clearly contradicts the explicit limitation that some notices are not collected.*"

It is noted that the claim language is not about collecting notices; it's about collecting the notified data. This is clear from the limitation: "*an information collection*

unit refers to the priority definition table upon reception of a notice from an information" (see claims 1 and 4 in both A1 and A2). While in the above statements Applicant appears to argue that the added new features in claims 1 and 4, which explicitly recited notice(s) with a priority below the threshold, would preclude the possibility of collecting all notified data. The examiner respectfully disagrees because both claims 1 and 4 use the word "if" in setting the "collecting" and "disregarding" scenarios. The claimed exception is not found in the claim languages.

In conclusion, the examiner believes that the previous finality was properly made. Applicant had been repeatedly told that the "preset priority" could be broadly interpreted as an arbitrary number. The arguments could have been subsided had Applicant chosen to further limit the claim languages.

Wen Jan Lin
3/7/05